



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,127	04/08/2004	Michael D. Laufer	064391-5001 US03	8654

43850 7590 08/03/2007
MORGAN, LEWIS & BOCKIUS LLP (SF)
2 PALO ALTO SQUARE
3000 El Camino Real, Suite 700
PALO ALTO, CA 94306

EXAMINER

WOO, JULIAN W

ART UNIT	PAPER NUMBER
----------	--------------

3731

MAIL DATE	DELIVERY MODE
-----------	---------------

08/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,127	Applicant(s) LAUFER ET AL.	
	Examiner Julian W. Woo	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/04, 10/25/04, 3/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-7, 9, 17, 18, 20, 24, 25, and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilk (5,395,367). Wilk discloses as claimed, at least in figure 7 and in col. 9, line 44 to col. 10, line 55; a tissue shaping instrument or apparatus including a proximal controlling end (at the vicinity of 38), a distal effector end (at the vicinity of 34, 35, and 36), an elongated portion (32, 34b, 35b, or 36b), and a first tissue engaging device (e.g., 36) and a second tissue engaging device (e.g., 35) or means for transorally engaging a plurality of regions of stomach tissue with a plurality of members (e.g., 34, 36) from within the stomach and means for pulling tissue located between the plurality of regions of tissue prior to engaging the plurality of regions of tissue (e.g., 35), where the instrument is an endoscopic instrument, where the instrument includes a tissue securing device or a stapler (see col. 10, lines 31-35), where the second tissue engaging device (e.g., 36) includes a jawed clamp, where the first tissue engaging device is non-piercing (e.g., 35), where at least a part of the

Art Unit: 3731

elongated portion is flexible (e.g., at the springs with the spring-loaded pins, 38, or portions of shafts 34b, 35b, and/or 36b), where the instrument includes at least one working channel (within 32), where the plurality of members includes a first member (e.g., 36) having a first securing part (one jaw of 36a) and second member (another jaw of 36a) having second securing part, where the engaging means includes a clamping device (e.g., 36), a suction device (not shown), or a grasping device (e.g., 35 or 36), and where the apparatus includes a means for securing the reconfigured tissue (e.g., a stapler or suture applicator).

3. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by McPherson et al. (5,437,266). McPherson et al. disclose, at least in the figures, an endoscopic tissue engaging device including a proximal controlling end (26), a distal effector end (at 24), and an elongated portion (38), where the distal end effector includes a helix (24) as claimed, and where the controlling end is structured to actuate the device (i.e., structured for receiving a wrench).

4. Claims 34, 35, 37, and 39-44 are rejected under 35 U.S.C. 102(e) as anticipated by Kuehn et al. (6,695,866). Kuehn et al. disclose, at least in figures 16, 17, and 19A-19D, an apparatus comprising an elongated member (126) configured for transoral placement in the stomach, where the elongated member having a steerable distal region including first and second movable members (at 404) configured to be moved toward one another, and means for deploying an implant from at least one of the members (404), where the first movable member includes a first securing part (424) and the second movable member includes a second securing part (426), where the

Art Unit: 3731

elongated member includes a clamping device or a grasping device (402), where the deploying means includes a distal end effector (402) configured to contact reconfigured stomach tissue, where the distal end effector includes a tissue fixation device (424, 426) configured for the application of a tissue fixation device, and where the apparatus includes means for controlling the distal end effector at a proximal end of the apparatus (432) and operatively connected to the distal end effector.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 4, 10-13, 21, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,395,367) in view of McGarry et al. (5,289,963). Wilk discloses the invention substantially as claimed. Wilk discloses a stapler as one of the tissue engaging devices or as a tissue securing device. However, Wilk does not disclose a tissue fixation device or a biocompatible, non-resorbable securing means that

Art Unit: 3731

is a staple and a stapler that is a one-sided stapler; nor does Wilk disclose that the instrument is sterilized. McGarry et al. teach, at least in figures 1 and 17-28 and in col. 10, lines 30-40 and col. 17, line 36 to col. 19, line 36; a tissue fixation device that is a biocompatible, non-resorbable securing means or a staple delivered from a one-sided stapler, where the stapler is sterilized. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of McGarry et al., to apply a one-sided stapler and a staple in the instrument of Wilk. Such devices would allow the endoscopic fastening of tissue, where the surgical site has narrow confines. It would also be obvious to sterilize the instrument, so that the instrument would not infect or contaminate the surgical site.

7. Claims 8, 26, 36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,395,367) in view of McPherson et al. (5,437,266). Wilk discloses the invention substantially as claimed, where the apparatus includes an elongated member (32 and/or 34b, 35b, 36b) with a steerable distal region (at 34b, 35b, or 36b) and a means for deploying an implant (e.g., a stapler or suture applicator (not shown)), and where the elongated member includes a suction device (not shown). However, Wilk does not disclose an engaging device or means that comprises a corkscrew-like retractor or a corkscrew element or an elongated member including the corkscrew element. McPherson et al. teach a a corkscrew-like retractor or a corkscrew element. It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of McPherson et al., to apply a corkscrew-like retractor or a corkscrew element in the instrument of Wilk. Such a device would allow the

secure, endoscopic fastening of tissue being manipulated or retracted during a surgical procedure.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,395,367) in view of Kuehn et al. (6,695,866). Wilk discloses the invention substantially as claimed, but does not disclose a tissue fixation device that is a two-part fastener. Kuehn et al. teach, at least in figures 17 and 19A-19D, a tissue fixation device that is a two-part fastener (424, 426). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Kuehn et al., to apply a tissue fixation device that is a two-part fastener in the instrument of Wilk. Such a fastener would allow the secure fastening of tissue with little risk of separation of joined tissues.

9. Claims 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,395,367) in view of Kammerer et al. (6,152,935). Wilk discloses the invention substantially as claimed, but does not disclose a tissue fixation device that is a suture or a T-bar suture. Kammerer et al. teach, at least in the figures, a suture or a T-bar suture (e.g., 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Kammerer et al., to apply a tissue fixation device that is a suture or a T-bar suture in the instrument of Wilk. Such a fastener would allow the endoscopic fastening or approximation of tissues during a minimally-invasive surgical procedure.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilk (5,395,367) in view of Yoon (5,954,731). Wilk discloses the invention substantially as

Art Unit: 3731

claimed, but does not disclose that instrument includes a viewing endoscope. Yoon teaches, at least in figure 4, an instrument with tissue engaging devices and a viewing endoscope (26). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Yoon, to include a viewing endoscope in the instrument of Wilk. Such a device would allow a surgeon to directly view a surgical site during a procedure and allow the surgeon to precisely manipulate the instrument within the surgical site.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Phillips (5,290,296) teaches a suture applicator, while Hauck et al. (6,575,971) teach a suction device.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3731

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Julian W. Woo". The signature is fluid and cursive, with the first name "Julian" being more prominent than the last name "Woo".

Julian W. Woo
Primary Examiner

August 2, 2007